

## **REMARKS**

By this Amendment, Applicants amend the specification to correct minor informalities, and amend claims 1, 6, 8, and 15 to more appropriate claim Applicants' invention. Support for the amendments made to claims 1, 6, 8, and 15 is found in the specification at least at page 14, lines 12-17, and page 19, lines 13-17. Claims 1-15 and 26 remain pending in this application.

### **I. IMPROPER FINALITY OF OFFICE ACTION**

At the outset, Applicants note that the Examiner indicated in the present Office Action that the Action was being made final "even though it is a first action after the filing of a request for continued examination and the submission under 37 CFR 1.114." See Final Office Action of November 22, 2004. In support of this contention, the Examiner cited MPEP § 706.07(b). Applicants respectfully disagree.

A Request for Continued Examination (RCE) was filed in this case on August 30, 2004, in order to gain entry of an Amendment After Final filed on June 30, 2004. The Examiner previously refused to consider or enter the Amendment After Final, and so stated in an Advisory Action of August 11, 2004. Specifically, the Advisory Action indicated that the proposed amendments would not be entered because the "new language requires new search and new consideration."

Since the amendments were denied entry, and Applicants subsequently filed an RCE, the finality of the present Office Action is improper. In particular, MPEP § 706.07(b) states that "it would not be proper to make final a first Office action in a continuing ... application where that application contains material which was presented in the earlier application after final rejection ... but was denied entry because (A) new

issues were raised that required further consideration and/or search.” Accordingly, the finality of the present Office Action is premature and should be withdrawn.

Moreover, MPEP § 706.07(d) provides that, if, “on request by applicant for reconsideration, the primary examiner finds the final rejection to have been premature, he or she should withdraw the finality of the rejection.” Applicants therefore request that the Examiner withdraw the finality of the present Office Action, enter and consider the amendments filed herewith, and so notify Applicants that the finality has been withdrawn in a supplemental Office communication.

## **II. RESPONSE TO PRESENT OFFICE ACTION**

In the Office Action, the Examiner objected to the disclosure because certain words included brackets of the type “[ ]” around them. Applicants have amended the specification to correct these minor informalities. Accordingly, Applicants request that the Examiner withdraw the objection to the disclosure.

The Examiner also maintained the rejection of claims 1-15 and 26 under 35 U.S.C. § 112, first paragraph, and the rejection of claims 1-15 and 26 under 35 U.S.C. § 103(a) as obvious over Aoshima et al. (U.S. Patent No. 6,241,524) in view of Yamada et al. (U.S. Patent No. 6,149,523) and in further view of Applicant’s Admission of Prior Art (AAPA). Applicants respectfully traverse these rejections for at least the following reasons.

In maintaining the rejection of claims 1-15 and 26 under 35 U.S.C. § 112, first paragraph, the Examiner reiterated assertions made in the Office Action of March 30, 2004. In that Office Action, the Examiner contended that the limitations “wherein the

special action was never before operable during the game” and “means for activating the operation of the special action of the displayed object for the first time during the progress of the game,” as recited in claim 1, and in independent claims 8 and 15 in a similar form, are not supported by the specification. See Office Action of March 30, 2004, at pages 2 and 8-9. Applicants respectfully disagree.

In an effort to expedite prosecution in this case, however, Applicants have amended independent claims 1, 8, and 15 to delete the above-noted claim language directed toward “the special action ... never before operation during the game,” and the “means for activating.” Accordingly, the rejection under 35 U.S.C. § 112, first paragraph has been rendered moot. Claims 2-7, 9-14, and 26 depend from independent claims 1 and 8, and thus, upon entry of the amendments, Applicants request the Examiner to reconsider and withdraw the rejection of claims 1-15 and 26 under 35 U.S.C. § 112, first paragraph.

Applicants respectfully traverse the Examiner’s rejection of claims 1-15 and 26 under 35 U.S.C. § 103(a) as obvious over Aoshima in view of Yamada and in further view of AAPA. To establish a proper *prima facie* case of obviousness under 35 U.S.C. § 103(a), the Examiner must demonstrate each of three requirements. First, the reference or references, taken alone or combined, must teach or suggest each and every element recited in the claims. See M.P.E.P. § 2143.03 (8<sup>th</sup> ed. 2001). Second, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to combine the references in a manner resulting in the claimed invention. See M.P.E.P. § 2143.01 (8<sup>th</sup> ed. 2001). Third, a reasonable expectation of success must exist. See M.P.E.P.

§ 2143.02 (8<sup>th</sup> ed. 2001). Moreover, each of these requirements must be found in the prior art, not in applicant's disclosure. See M.P.E.P. § 2143 (8<sup>th</sup> ed. 2001). Applicants respectfully submit that the Examiner has not established a *prima facie* case of obviousness.

Claim 1 as amended, recites "means for presenting the prompt relating to the special action through a dialogue spoken by a second character to the first character, the dialogue being incorporated into a situation from the game and suggesting the key operation corresponding to the special action to a player." Aoshima, Yamada, and AAPA, whether taken alone or in combination, do not disclose or suggest at least this feature of claim 1.

Aoshima teaches that a player can see advice outputted onto a game image while playing the game since the advice is displayed on the image. See col. 2, lines 1-7. Aoshima also discloses that advice depending on a state of the game may be generated as sounds that are outputted through a sound generating means. See col. 2, lines 10-13. Aoshima, however, does not disclose or suggest at least "means for presenting the prompt relating to the special action through a dialogue spoken by a second character to the first character, the dialogue being incorporated into a situation from the game," as recited in amended claim 1. Instead, Aoshima merely discloses that advice is displayed in a window superimposed on the game image or generated by sounds, neither of which are described in Aoshima as being associated with game characters. See col. 2, lines 1-33, and Figures 9 and 10, for example.

Furthermore, Yamada does not overcome the above-described deficiencies of Aoshima. Yamada discloses displaying identification symbols for visually identifying

details of a game operation. See col. 2, lines 35-40. Yamada also teaches using identification sounds to aurally identify a game operation, such as musical sounds output as if keys of a piano have been struck. See col. 3, lines 13-15, and col. 6, lines 34-38. These sounds, however, do not constitute at least “means for presenting the prompt relating to the special action through a dialogue spoken by a second character to the first character, the dialogue being incorporated into a situation from the game,” as recited in amended claim 1.

AAPA does not cure the shortcomings of Aoshima and Yamada. Applicants note that the Examiner cited statements in the specification that “existing simulation games include a scene for training in key operations, called ‘practice mode’” and that “[t]he player can practice the key operations until the display object can use these techniques” (specification, page 2, lines 4-19). The Examiner contended that these statements suggest that a game action “becomes operable for a first time in the game once all the key operations are correct.” See March 30, 2004, Office Action, page 6. Although Applicants’ disagree with the Examiner’s characterization of Applicants’ specification, such teachings, even if admitted prior art, would still fail to address the above-described deficiencies of Aoshima and Yamada. In particular, AAPA is also silent at least as to the “means for presenting the prompt relating to the special action through a dialogue spoken by a second character to the first character, the dialogue being incorporated into a situation from the game,” as recited in amended claim 1. Accordingly, for at least the above reasons, amended claim 1 is not obvious over Aoshima, Yamada, and AAPA. Claim 1 is therefore allowable over the applied references.

Independent claims 8 and 15, while of a different scope from claim 1 and each other, have been amended to include recitations similar to those recited in claim 1. Independent claims 8 and 15 are thus allowable for at least the same reasons as claim 1. Moreover, claims 2-7, 9-14, and 26 are allowable at least due to their corresponding dependence from claims 1 and 8.

**CONCLUSION**

In view of the foregoing remarks, Applicants respectfully request reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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